



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,160	06/30/2003	Yoshiko Naitoh	03560.003328.	8128

5514 7590 02/05/2007
FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

HUSSAIN, TAUQIR

ART UNIT	PAPER NUMBER
----------	--------------

2152

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/608,160

Applicant(s)

NAITOH, YOSHIKO

Examiner

Tauqir Hussain

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 08/06/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-22 are pending in this application.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 21 and 22 are rejected under 35 U.S.C. 101 because applicant merely discloses the subject matter in the specification. Therefore, it fails to fall into one of the four statutory classes of invention: process, machine, manufacture, or composition of matter.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claim 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 1, 11, 21 and 22 recites, "comparing means for comparing a combination of first device identification information and second device identification information which are obtained from the predetermined device with another combination" in lines 3-6; 4-8; 4-7 and 5-8. It is not clear what is the other combination applicant is referring to.

However in the light of specification paragraph 61-63 examiner consider applicant is referring to first ID and second ID of the same device for examining purposes.

7. Claim 1, is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: There are missing structural elements of the apparatus which needs to be included in the claim, further there is no connection between first limitation (as what happens after the comparison is done, or what is the next step based on comparison output) and the second limitation (is this notification is related to the comparison or how is this notification related to external apparatus or predetermined device).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 1-22, are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlonski et al. (Pub. No.: US 2003/0093521 A1), hereinafter "Schlonski" in view of Yada (Pub. No.: Us 2001/0029474 A1), hereinafter "Yada".

10. As to claim 1, 11, 21 and 22, Schlonski discloses, an information processing apparatus that manages a predetermined device capable of performing communication over a network (Fig.1, Element-14, Network Server), comprising:

comparing means for comparing a combination of first device identification information and second device identification information which are obtained from the predetermined device with another combination ([0016, lines 12-18]; where IP address and Mac address are used as asset identification and [0022, lines 1-7]; where based on that ID is compared with the ID's in the database);

the external apparatus being capable of receiving the notification through a predetermined communications line and managing a plurality of information processing apparatuses ([0025, lines 1-5]).

Schlonski does not disclose, communication controlling means for controlling issuance of a notification to an external apparatus in accordance with a result of the comparison by the comparing means. However, Yada teaches, communication controlling means for controlling issuance of a notification to an external apparatus in accordance with a result of the comparison by the comparing means ([0017, lines 6-10])

Therefore, it would have been obvious to one ordinary skilled in the art at the time the invention was made to modify the teachings of Schlonski with the teachings of Yada in order for server to manage network resources efficiently by allocating available resources as per demand and network device availability.

11. As to claim 2 and 12, Schlonski discloses, an information processing apparatus (Fig.1, Element-14, Network Server), wherein the comparing means determines whether or not at least one of the first device identification information and the second device identification information is being managed (Fig.1, Printers, [0022, lines 1-7], where it can clearly seen that printers have different status e.g. newly discovered printer can be interpret as managed), and the notification issued by the communication controlling means includes information indicating that either the first device identification information or the second device identification information is not being managed (Fig.1, Printers, [0038, lines 1-3], where it can clearly seen that printers have different status e.g. unconfigured/error/unassigned can be interpret as unmanaged).

12. As to claim 3 and 13, Schlonski discloses, an information processing apparatus (Fig.1, Element-14, Network Server), further comprising receiving means for receiving information corresponding to the first device identification information and the second device identification information from the external apparatus through the communications line (0033, lines 1-7], where history of all the network assets are retained in a database and can be recalled); and

holding means for holding the corresponding information received by the receiving means, wherein the comparing means compares the corresponding information held by the holding means with the combination of the first device identification information and the second device identification information which are obtained from the predetermined device ([0032, lines 1-3], where asset information is kept in database along with its history).

13. As to claim 4 and 14, Schlonski discloses, an information processing apparatus (Fig.1, Element-14, Network Server), further comprising updating means for updating first device identification information and second device identification information which are held by a holding section in accordance with a notification, for updating the combination of the first device identification information and the second device identification, from the external apparatus ([0039, lines 1-7], where asset information is updated in the database manager).

14. As to claim 5 and 15, an information processing apparatus (Fig.1, Element-14, Network Server), further comprising inputting means for inputting an instruction for updating the first device identification information and/or the second device identification information, wherein the communication controlling means issues a notification for update, based on the update instruction input by the inputting means, to the external apparatus ([0025, lines 7-12], where manual entries added in the printer information properties and [0022, lines 6-7], where printer information is added in the database).

15. As to claim 6 and 16, Schlonski discloses, an information processing apparatus (Fig.1, Element-14, Network Server), further comprising obtaining means for obtaining accounting information based on an image forming operation of a predetermined device from the predetermined device ([0018, lines 8-13], where print count can be interpret as accounting information based on image forming operation), wherein the communication controlling means issues the accounting information obtained by the obtaining means to the external apparatus and the external apparatus receives the accounting information and saves the accounting information in accordance with a notification that is issued by the communication controlling means based on a result of the comparison ([0018, lines 13-17], where asset manager keeps the history and accounting information into database).

16. As to claim 7 and 17, Schlonski discloses, an information processing apparatus (Fig.1, Element-14, Network Server), further comprising accounting-information generating means for generating accounting information based on an image forming operation of a predetermined device (Fig.7, Reports [0018, lines 8-13], where reports can be interpret as generating accounting information); and

restricting means for restricting issuance of a notification of the accounting information generated by the accounting-information generating means to the external apparatus ([0039, lines 11-15], where import and export of a report is an option in asset

Art Unit: 2152

management, which means reports does not transmit automatically to asset management).

17. As to claim 8 and 18, Schlonski discloses, an information processing apparatuses (Fig.1, Element-14, Network Server), further comprising determining means for determining whether or not a problem of a combination of first device identification information and second device identification information is solved ([0042, lines 1-5]); and

removing means for removing the restriction by the restricting means, based on the determination by the determining means ([0042, lines 7-13], where new asset number means old asset number is either discarded or removed or updated with the new asset number).

18. As to claim 9 and 19, Schlonski discloses, an information processing apparatus (Fig.1, Element-14, Network Server), wherein the first device identification information is an internet protocol address ([0016, lines 12-13]).

19. As to claim 10 and 20, Schlonski discloses, an information processing apparatus (Fig.1, Element-14, Network Server), wherein the second device identification information includes at least MAC address information ([0016, lines 15-18]).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tauqir Hussain whose telephone number is 571-272-1247. The examiner can normally be reached on 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571 272 3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TH



BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER